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PATENT APPLICATION

ATTORNEY DOCKET NO. 10008212-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Simpson, et al.

Confirmation No.: 7884

Application No.: 10/003,150

Examiner: Fadok, Mark

Filing Date: 11-2-01

Group Art Unit: 3625

Title: Pay-For-Printing System and Method

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 5-4-06.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500 . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Simpson, et al.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Simpson, et al.

Serial No.: 10/003,150

Filed: November 2, 2001

Group Art Unit: 3625

Examiner: Fadok, Mark

Docket No. 10008212-1

For: **Pay-For-Printing System and Method**

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed May 4, 2006, responding to the Final Office Action mailed February 9, 2006.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

06/27/2006 BABRAHA1 00000085 082025 10003150

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I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 5, 6, 8-10, and 14-29 have been canceled, leaving claims 1-4, 7, 11-13, and 30 remaining. Each of those claims stand finally rejected. No claims have been allowed. The final rejections of claims 1-4, 7, 11-13, and 30 are appealed.

IV. Status of Amendments

This application was originally filed on November 2, 2001, with twenty-nine (29) claims. In a Response filed May 31, 2005, Applicant withdrew claims 8-10 and 14-29. In a Response filed November 14, 2005, Applicant amended claims 1, 3, 7, 11-13 and added new claim 30.

All of the above-identified amendments have been entered and no other amendments have been made to any of claims 1-4, 7, 11-13, and 30. The claims in the attached Claims Appendix (see below) reflect the present state of those claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description (“specification”) and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Independent claim 1 describes a method for facilitating pay printing. The method comprises a network-based printing service (318, Figure 3) retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network. *Applicant’s specification*, page 25, lines 13-18; Figure 8, item 806. The method of claim 1 further comprises the printing service receiving print option selections. *Applicant’s specification*, page 26, lines 11-13; Figure 8, item 810. The method of claim 1 further comprises the printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version. *Applicant’s specification*, page 26, lines 13-15; Figure 8, item 812.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are to be reviewed on appeal:

1. Claims 1-4, 7, 11, 13, and 30 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Garfinkle* (U.S. Pat. No. 6,924,878).

2. Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Garfinkle* in view of *Official Notice*.

VII. Arguments

The Appellant respectfully submits that Applicant's claims are neither anticipated under 35 U.S.C. § 102 nor obvious under 35 U.S.C. § 103, and respectfully requests that the Board of Patent Appeals overturn the final rejections of those claims at least for the reasons discussed below.

A. Claim Rejections - 35 U.S.C. § 102(e)

Claims 1-4, 7, 11, 13, and 30 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Garfinkle* (U.S. Pat. No. 6,924,878). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore,

every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Garfinkle reference. Applicant discusses the Garfinkle reference and Applicant's claims in the following.

1. The Garfinkle Disclosure

Garfinkle discloses a method of processing a roll of exposed photographic film. *Garfinkle*, Patent Title. In the method, photographic film is sent to a developer 12 where the photographic film is developed and scanned to acquire digital images of the captured film images. *Garfinkle*, column 3, lines 45-53. The digital images are then stored on an image server 16. *Garfinkle*, column 3, lines 49-53. The photographer 8 that captured the film images can then access the digital images using a browser and request various tasks, including printing the images. *Garfinkle*, column 6, lines 1-20.

2. Discussion of Applicant's Claims

Applicant's claim 1 provides as follows (emphasis added):

1. A method for facilitating pay printing, the method comprising:

a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network;

the printing service receiving print option selections; and

the printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version.

(a) No Teaching of a “Network-Based Printing Service” Retrieving a Scaled-Down Version of a Full-Sized Document

As a first matter, Garfinkle does not teach “a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network”. In addressing this issue, the Examiner cited column 6, lines 1-25 of the Garfinkle reference. *Final Office Action*, page 3. That portion of the reference provides as follows:

In a most preferred embodiment, the photographer 8 accesses HTML pages from a WWW browser using either the Secure HyperText Transport Protocol (HTTPS) or HyperText Transport Protocol (HTTP) to access a Netscape Enterprise Server running on an Axil 320 Sparc acting as the image server. The Netscape server is configured with an HTML forms interface which accepts the unique access code and provides access to thumbnails (small replicas of the full digital image) of the images in the roll in the form of an online proof sheet. The interface B allows the photographer 8 to perform specific tasks using the digital images, such as the ability to electronically mail (e-mail) an image to another party; download an image to the photographer's home computer 9f, see FIG. 9C; or order a visual print of a specific image in a variety of formats and sizes, such as photographic prints or enlargements of photographic prints, and photographic merchandise including T-shirts, sweatshirts, mugs, mouse pads, puzzles, ties, buttons, electronic slide shows, and other items bearing the digital image.

It will be appreciated that when downloading or e-mailing a digital image, the resolution of the digital image is preferably reduced to a screen size of 600×400 pixels or 712×512 pixels. These sizes are more appropriate for screen display of the digital images, and allow faster transfer of the data over a network.

Garfinkle, column 6, lines 1-25.

In the above excerpt, the *photographer*, not any “network-based printing service” can retrieve an online proof sheet that contains small replicas of his images. Therefore, Garfinkle fails to anticipate claim 12 for at least that reason.

(b) No Teaching of a Printing Service “Determining Printing Costs for Printing the Full-Size Document Based Upon Attributes of the Scaled-Down Version”

Irrespective of the above, it is *abundantly clear* that Garfinkle fails to teach a “printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version”. As to this issue, the Examiner identified column 9, lines 53-65 (*Final Office Action*, page 3), which provide:

When the photographer 8 uploads one or more digital images directly to the image server 16, these images are either added to a set of images already associated with an access code or the new images are assigned a new unique access code. When a new access code is assigned, a price sheet must be associated with these images in order to provide to the photographer 8 the visual prints which may be ordered using the new images. In a preferred embodiment, the photographer 8 selects a fulfillment center 20 which they prefer to use to fulfill all orders placed

using the new images. A price sheet is associated with each fulfillment center 20, and this price sheet forms the basis for the products available to the photographer 8, and the prices of these products.

Garfinkle, column 9, lines 53-65.

As can be appreciated from the above, described by Garfinkle are:

- (i) uploading new images to a server,
- (ii) assigning a new access code to the images,
- (iii) associating a price sheet with images, and
- (iv) selecting of a “fulfillment center” that will “fulfill all orders placed using the new images.”

Clearly missing from Garfinkle’s disclosure, however, is a teaching of determining printing costs based upon “attributes” of “scaled-down versions” of the images. Simply stated, Garfinkle fails to contemplate such a system or method. Instead, Garfinkle only says that the user selects a printing service and that a “price sheet” is available to the user. For all the reader knows, the price sheet contains flat rate prices per image irrespective of the content of the image data to be printed. Regardless, given that Garfinkle is silent as to the service (i.e., fulfillment center 20) determining costs based upon scaled-down version of the user’s images, the Garfinkle reference cannot be said to anticipate Applicant’s claim 1.

In view of at least the foregoing, it is clear that Garfinkle does not anticipate claim 1, or the claims that depend from claim 1. Accordingly, Applicant requests that the rejections be withdrawn.

(c) Examiner's Comments in the Advisory Action

In response to Applicant's arguments, the Examiner stated that Applicant is "reading to [sic] much into the otherwise broad features described in claim 1." *Advisory Action*, page 2. Applicant submits, however, that Applicant is merely reading the explicit words of claim 1. Applicant requests the Examiner to identify *with specificity* which sentence or sentences of Garfinkle's disclosure actually describe a network-based printing service "retrieving a scaled-down version of a full-sized document" or determining printing costs for printing "based upon attributes of the scaled-down version". Applicant submits that the Examiner cannot do this because Garfinkle does not provide such a teaching. It appears that it is the Examiner that is reading too much into Garfinkle's disclosure. In particular, the Examiner is making inferences that are simply not supported by Garfinkle's actual teachings.

Again, Garfinkle only describes the photographer reviewing his images in thumbnail form, and separately selecting a printing service to print the images represented by the thumbnails. *Nowhere* does Garfinkle describe what criteria the printing service uses to determine what the cost for printing the images will be. Moreover, Garfinkle never states that the price is determined based upon attributes of the thumbnails. Indeed, quite to the contrary, Garfinkle appears to describe a static "price sheet" that is provided irrespective of the nature of the images to be printed or their content. Accordingly, it appears that Garfinkle actually teaches away from a price determination based upon the user's particular images, whether they be in thumbnail or full format.

Furthermore, it appears as though the Examiner is making an obviousness argument when the Examiner discusses the “knowledge that would have been generally available to one of ordinary skill in the art.” In particular, it appears as though the Examiner is admitting that Garfinkle does not actually teach a printing service retrieving a scaled-down version of a full-sized document and determining printing costs based upon attributes of the scaled-down version, but that it would have been obvious to make such a determination to a person having ordinary skill in the art. Given that the rejection is under 35 U.S.C. § 102, such an argument has no place in the rejection.

Finally, as to the Examiner’s comments as to Applicant not specifically pointing out the supposed errors, Applicant provides the following restatement or summation of Applicant’s arguments:

The Examiner has erred by failing to identify that Garfinkle’s “fulfillment center 20” downloads a scaled-down version of a user’s images or determines printing costs based upon attributes of the scaled-down version.

Applicant does not know how to identify that failing any clearer for the Examiner. Garfinkle discloses nothing of the sort and therefore cannot be said to anticipate claim 1.

B. Claim Rejections - 35 U.S.C. § 103(a)

Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Garfinkle* in view of *Official Notice*. Applicant respectfully traverses this rejection.

As is identified above, Garfinkle does not teach several aspects of Applicant's claim

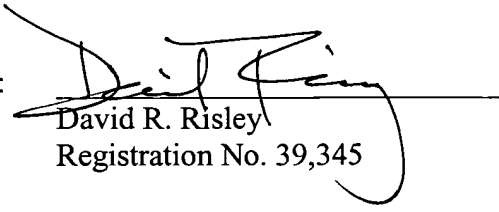
1. Applicant therefore submits that claim 12, which depend from claim 1, is allowable over the Garfinkle for at least the same reasons that claim 1 is allowable over Garfinkle.

VIII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

By:


David R. Risley
Registration No. 39,345

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12-22-06
Mary M. Leary
Signature

Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1. A method for facilitating pay printing, the method comprising:
a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network;
the printing service receiving print option selections; and
the printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version.
2. The method of claim 1, wherein the at least one store comprises a graphic store and a composition store.
3. The method of claim 1, wherein the at least one store is associated with an imaging source with which the full-sized document is created or identified.
4. The method of claim 3, wherein the imaging source comprises a network-based imaging service.
- 5-6. (Canceled)
7. The method of claim 1, wherein the scaled-down version comprises one or more thumbnails that represent document pages.

8-10. (Withdrawn)

11. The method of claim 1, wherein receiving print option selections comprises receiving user selections with a web site of the network-based printing service.

12. The method of claim 11, wherein the printing service is supported by a printing device having an embedded server.

13. The method of claim 1, wherein the determination of the printing costs is dependent upon attributes of the scaled-down version and the option selections.

14-29. (Withdrawn)

30. The method of claim 1, wherein the scaled-down version is created by a network-based imaging service with which the full-sized document was created or identified.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.